

REMARKS

New Grounds of Rejection

On December 21, 2007, the Board issued a *Decision on Appeal* including three new grounds of rejection made pursuant to 37 C.F.R. § 41.50(b). The first rejection concerned the purported indefiniteness of claims 1-18 and 23-29 (*i.e.*, all pending claims) under 35 U.S.C. § 112, ¶ 2 "based on the use of the phrase 'independent variable' and the use of the term 'randomly.'" *Decision on Appeal*, 4. The Board did not identify which (if any) claims were rejected on the issue of 'independent variable' versus 'randomly.' Second, the Board rejected claims 1-13 and 16-18 for lack of enablement under 35 U.S.C. § 112, ¶ 1 due to the purported need "to resort to undue experimentation to derive or select an 'independent variable.'" *Decision on Appeal*, 4. The Board similarly found that "the skilled artisan would have to resort to an undue amount of experimentation to be able to 'randomly' select an interior point within [a] graphics primitive." *Decision on Appeal*, 4. Finally, the Board found all pending claims to lack written description under 35 U.S.C. § 112, ¶ 1 as the term 'randomly' is purportedly absent from the originally filed disclosure. *Decision on Appeal*, 5.

In accordance with 37 C.F.R. § 41.50(b)(1), the Applicants hereby present an amendment to certain claims rejected by the Examiner. These amendments are made to address the 'independent variable' rejection raised by the Examiner in the context of 35 U.S.C. § 112, ¶ 2 and, to a lesser extent, the enablement rejection raised under 35 U.S.C. § 112, ¶ 1 with respect to this same claim language. As is discussed in further detail below, the enablement rejection is believed to be premature. No amendments have been made to address the 'randomly' limitation; this rejection is rendered under 35 U.S.C. § 112, ¶ 1 for a purported lack of enablement and written description in addition to 35 U.S.C. § 112, ¶ 2 in the context of indefiniteness.

As such, an amendment is made to less than all of the claims rejected by the Board under 37 C.F.R. § 41.50(b) and thus effectively constitutes a request for a rehearing as to the rest of the claims so rejected. The Applicants acknowledge that “[t]he request for rehearing will be considered by the Board after prosecution before the examiner with respect to the first group of claims is terminated.” MPEP § 1214.01. That is, the Applicants believe it is appropriate for the Examiner to re-open prosecution to address (specifically) the 35 U.S.C. § 112, ¶¶ 1 and 2 rejections with respect to an ‘independent variable.’ A request for rehearing should then be commenced by the Board on the indefiniteness, enablement, and written description rejections as they concern the ‘randomly’ limitation.

Purported Indefiniteness of an Independent Variable

The Applicants have eliminated the language ‘independent variable’ in independent claims 1, 8, 9, and 13; this language was eliminated in favor of the new language ‘a variable at a point being processed.’ This amendment finds support in the specification, at the least, on page 16 at lines 7-8. No such limitation concerning an ‘independent variable’ is found in independent claims 14 and 15. Reference to an ‘independent variable’ in claims 23 and 27 concerns an ‘independent variable X representing the physical portion of a randomly selected point.’ The specificity provided in claims 23 and 27 “point[s] out and distinctly define[s] the metes and bounds of the subject matter that will be protected by the patent grant.” MPEP § 2171. As such, there is no indefiniteness to be found with respect to this language.

Purported Indefiniteness of Randomly

Random selection or randomly selecting is found in each and every independent claim of the present application. The Board contends such a term to be indefinite for lack of definition of the same in the specification. See *Decision on Appeal*, 4. Section 112, ¶ 2 allows an applicant to “define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification.” MPEP § 2173.01 (citing MPEP § 2111.01).

The Applicants, here, are not using the term ‘random’ or ‘randomly’ in any way that departs from its plain and ordinary meaning as it would be understood by one of ordinary skill in the art; no ‘special meaning’ is imposed. Accordingly, a claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernable; the reader may “infer the meaning of the entire phrase with reasonable confidence” because the term has a “well recognized meaning.” *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372 (Fed. Cir. 2004); see also *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366 (Fed. Cir. 2004) (“[t]he requirement to ‘distinctly’ claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles”). In light of these principles, the Applicants contend that the Board’s new ground of rejection is overcome.

Enablement

Before the Examiner may make an enablement rejection and, in that regard, “[b]efore any analysis of enablement can occur, it is necessary for the examiner to construe the claims.” MPEP § 2164.04 (citing *Genentech v. Wellcome Foundation*, 29 F.3d 1555, 1563-64 (Fed. Cir. 1994)) (emphasis added). The Board has stated, in its decision on appeal, that “[i]n view of the lack of an explanation as to what constitutes an ‘independent variable,’ and the complete lack of description in the originally filed disclosure of the term ‘randomly,’ we are not able to define

the metes and bounds of the claims invention." *Decision on Appeal*, 3. "Accordingly, the prior art rejections of claims 1 to 18 and 23 to 29 are reversed because a prior art rejection can not (sic) be sustained if the hypothetical person of ordinary skill in the art would have to make speculative assumptions concerning the meaning of [the] claim language." *Decision on Appeal*, 3-4 (citing *In re Steele*, 305 F.3d 859, 862-63 (CCPA 1962) (emphasis added). Thus, by virtue of the Board's own rejection, consideration of whether the claims are enabled is premature in that the claims (according to the Board) cannot be construed absent a speculative assumption.

Notwithstanding the prematurity of the enablement rejection, the Applicants contend that the claims are enabled. Enablement "requires a determination of whether that disclosure, when filed, contained **sufficient information regarding the subject matter** of the claims as to enable **one skilled in the pertinent art to make and use the claimed invention**." MPEP § 2164.01 (emphasis added). The standard for determining whether the specification meets the enablement requirement is whether any person skilled in the art can make and use the invention without undue experimentation. See *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988) and *United States v. Teletronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988); see also *In re Angstadt*, 537 F.2d 498, 504 (CCPA 1976) (noting that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue).

The Applicants note that the specification discusses that "[t]he method of the present invention is **generalized** so that **any** desired value at a given point **can be derived** from known values at vertices." See *Specification*, p. 6, l. 5-6 (emphasis added). The specification further notes that techniques disclosed in the context of the present invention "facilitate[] computation on an as-needed basis, so that any required computations . . . may be deferred until needed" and that "[p]ixels may be generated in any convenient order, without the sequential limitations of incremental methods." *Specification*, p. 5, l. 23-p.6, l. 1. As a result, "computation may be performed on an as-needed or random-access basis." *Specification*, p. 6, l. 4-5. As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement

of 35 U.S.C. 112 is satisfied. See *In re Fisher*, 427 F.2d 833, 839 (CCPA 1970). The Applicants believe—again, notwithstanding the prematurity of the rejection—that the aforementioned description in conjunction with the knowledge of one skilled in the art would not warrant any undue experimentation if any experimentation at all.

Still further, the Applicants note that:

[a] specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

MPEP § 2161.04. “[I]t is incumbent upon the Patent Office . . . to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.” *In re Marzocchi*, 439 F.2d 220, 224 (CCPA 1971). Absent such an explanation and evidence in support of the same, there is “no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.” *Id.*

The Applicants contend any such reasoning to be lacking in that the Board has merely issued a blanket enablement rejection that appears to be based on little more than the absence of the word ‘randomly’ in the specification. The Applicants respectfully contend that such reasoning is hardly sufficient to meet the standards described above and, further, to satisfy the burden established by *In re Wright* whereby the examiner (*i.e.*, the Board) has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). As such, and notwithstanding the prematurity of the present rejection, the Applicants contend the rejection to be overcome.

Written Description

The Board's third and final rejection pertains to a purported lack of written description with respect to the claim language 'randomly.' See *Decision on Appeal*, 5. An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989); see also *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985) (querying whether the disclosure of the application "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter") (quoting *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983)).

As was the case with the enablement rejection, the Applicants believe that the specification's discussion that "[t]he method of the present invention is **generalized** so that **any** desired value at a given point **can be derived** from known values at vertices" reasonably conveys to one skilled in the art that the inventors has possession of the presently claimed invention at the time of filing. See *Specification*, p. 6, l. 5-6 (emphasis added). The specification further notes that techniques disclosed in the context of the present invention "facilitate[] computation on an as-needed basis, so that any required computations . . . may be deferred until needed" and that "[p]ixels may be generated in any convenient order, without the sequential limitations of incremental methods." *Specification*, p. 5, l. 23-p.6, l. 1. As a result, "computation may be performed on an as-needed or random-access basis." *Specification*, p. 6, l. 4-5.

The Applicants respectfully remind the Board that the subject matter of the claim need not be described literally (*i.e.*, using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. See MPEP § 2163.02. In that regard, the Applicants believe they have evidenced possession of the presently claimed invention including but not limited to the 'randomly' limitation addressed by the Examiner. As such, the Applicants contend that the written description rejection is overcome.

CONCLUSION

The Applicants believe that the amendment to the claims overcomes the Examiner's 35 U.S.C. § 112, ¶ 2 rejection as to an 'independent variable.' The Applicants also believe that this amendment overcomes any enablement rejection as to this particular claim element although such a rejection, by the Board's own logic, is believed to be premature and should be subject to further consideration *only* after the Section 112, paragraph 2 rejection as to all claim elements is resolved.

Further, the Applicants believe that 'randomly' is not indefinite as evidenced in the remarks above. The Applicants also believe that such a claim element is sufficiently enabled although this element, too, should only be considered after resolution of the indefiniteness rejection. The Applicants further believe proper written description to exist for this term.

The Examiner and/or Board are invited to contact the Applicants' undersigned representative with any further questions in this matter.

Respectfully submitted,
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